

ESTTA Tracking number: **ESTTA982160**

Filing date: **06/20/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	DC Comics
Granted to Date of previous extension	06/23/2019
Address	2900 West Alameda Avenue Burbank, CA 91505 UNITED STATES

Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 151 West 42nd Street 17th Floor New York, NY 10036 UNITED STATES jweinberger@fzlz.com, lkittay@fzlz.com, sharb@fzlz.com (212) 813-5900
----------------------	---

Applicant Information

Application No	87737825	Publication date	12/25/2018
Opposition Filing Date	06/20/2019	Opposition Period Ends	06/23/2019
Applicant	Buolamwini, Joy 75 Amherst Street Cambridge, MA 02139 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2016/10/31 First Use In Commerce: 2016/10/31 All goods and services in the class are opposed, namely: Organizing and developing charitable projects that aim to promote awareness of and combat bias in algorithms as used in artificial intelligence and automated decision-making technology

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1190681	Application Date	01/23/1981
-----------------------	---------	------------------	------------

Registration Date	02/23/1982	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE OF AMERICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1960/08/25 First Use In Commerce: 1960/08/25 Comic Magazines		


U.S. Registration No.	1503856	Application Date	09/14/1987
Registration Date	09/13/1988	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1960/08/25 First Use In Commerce: 1960/08/25 COMIC MAGAZINES		


U.S. Registration No.	2998011	Application Date	07/30/2004
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2001/11/00 First Use In Commerce: 2001/11/00 Entertainment services in the nature of [live-action,] comedy, drama and animated television series; production of [live-action,] comedy, drama and animated [television series; distribution and display of live-action, comedy, drama and animated] motion picture theatrical films; [production of live-action, comedy, drama and animated motion picture theatrical films; theatrical performances both animated and live action; Internet services providing information via an electronic global computer network in the field of entertainment relating specifically to music, movies, and television; providing general interest news, entertainment, and educational information via a global computer network; and providing in-		

	formation for and actual entertainment via electronic global communications network in the nature of live-action, comedy, drama and animated programs and production of live-action comedy, action and animated motion films for distribution via a global computer network]
--	---


U.S. Registration No.	2998012	Application Date	07/30/2004
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2001/08/31 First Use In Commerce: 2001/08/31 Motion picture films featuring comedy, drama, action, adventure and/or animation, [and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; prerecorded vinyl records, audio tapes, audio-video tapes, audio video cassettes,] audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; [stereo headphones; batteries; cordless telephones; hand-held calculators; audiocassette and CD players;] CD ROM computer game discs; [hand-held karaoke players, telephone and/or radio pagers; shortmotion picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors; video cassette recorders and players, compact disc players, digital audio tape recorders and players, electronic diaries; radios;] mouse pads; eyeglasses, sunglasses and cases therefore [; audio tapes and booklets sold as a unit featuring comedy, drama, action, adventure, animation and music information; computer programs, namely, software linking digitized video and audio media to a global computer information network; game equipment sold as a unit for playing a parlor-type computer game;] video and computer game programs; [videogame cartridges and cassettes; cellular telephone accessories, namely, hands-free accessories,] cellular telephone covers and cellular telephone face covers; [encoded magnetic cards, namely, phone cards, credit cards, cash cards, debit cards and magnetic key cards;] and decorative magnets</p>		


U.S. Registration No.	2998021	Application Date	07/30/2004
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Clothing for men, women and children - namely, shirts, T-shirts, sweatshirts, jogging suits, [trousers,] pants, shorts, tank tops, rainwear, [cloth baby bibs, skirts, blouses, dresses, suspenders,] sweaters, jackets, coats, [raincoats, snow suits, ties, robes,] hats, caps,[sunvisors,] belts, [scarves,] sleepwear, pajamas, [lingerie,] underwear,boots, shoes, sneakers, sandals, [booties,] slipper socks, swimwear and masquerade and Halloween costumes and masks sold in connection therewith


U.S. Registration No.	2998022	Application Date	07/30/2004
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Toys and sporting goods, including games and playthings--namely, action figuresand accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; [equipment sold as a unit for playing cardgames; toy vehicles;] dolls; [flying discs; electronic hand-held game unit;]game equipment sold as a unit for playing a board game, a card game, a manipulative game, [a parlor game] and an		


	action type target game; [stand alone videooutput game machines;] jigsaw and manipulative puzzles; paper face masks; [skateboards; water squirting toys;] balls--namely, playground balls, [soccer balls,] baseballs, [basketballs]; base-ball gloves; swimming floats for recreational use; kickboard flotation devices for recreational use; [surfboards;] swim boards for recreational use; [swim fins; toy banks; toy snow globes; and Christmas tree ornaments]
--	--

U.S. Registration No.	3257160	Application Date	02/03/2006
Registration Date	06/26/2007	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE HEROES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/10/17 First Use In Commerce: 2006/10/17 computer and video game programs which are designed for hardware platforms suchas game consoles and personal computers; CD-ROM computer game discs and computer programs, namely, software linking digitized video and audio media to a globalcomputer information network; video andcomputer game programs; video game cartridges and cassettes		

U.S. Registration No.	5699073	Application Date	03/08/2018
Registration Date	03/12/2019	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2013/01/00 First Use In Commerce: 2013/01/00 adhesive plastic bandages for skin wounds		

U.S. Registration	5699075	Application Date	03/08/2018
-------------------	---------	------------------	------------

No.			
Registration Date	03/12/2019	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2004/00/00 First Use In Commerce: 2004/00/00 Glass and ceramic goods, namely, mugs, coffee cups, and cups; glass beverageware; lunch boxes; thermal insulated containers for food or beverages; water bottles sold empty		

U.S. Registration No.	5704943	Application Date	03/08/2018
Registration Date	03/19/2019	Foreign Priority Date	NONE
Word Mark	JUSTICE LEAGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2004/00/00 First Use In Commerce: 2004/00/00 metal key chains, non-metal key chains;clocks; watches; jewelry		

Attachments	78459657#TMSN.png(bytes) 78459673#TMSN.png(bytes) 78459924#TMSN.png(bytes) 78459927#TMSN.png(bytes) 78807018#TMSN.png(bytes) 87826234#TMSN.png(bytes) 87826514#TMSN.png(bytes) 87826266#TMSN.png(bytes) F3096601.pdf(158722 bytes)
-------------	---

Signature	/s/ James D. Weinberger
Name	James D. Weinberger
Date	06/20/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DC COMICS,

Opposer,

-against-

JOY BUOLAMWINI,

Applicant.

NOTICE OF OPPOSITION

DC Comics (“Opposer”), a New York partnership located at 2900 W. Alameda Ave., Burbank, California 91505, believes that it will be damaged by the issuance of a registration for the mark ALGORITHMIC JUSTICE LEAGUE to Joy Buolamwini (“Applicant”), in International Class 35, applied for in Application Serial No. 87/737,825 (the “Application”) and therefore opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946, 15 U.S.C. § 1063(a).

As grounds therefore, Opposer alleges as follows:

1. Opposer, on its own and through its predecessors-in-interest (referred to collectively herein as “Opposer”), is the publisher of comic books and magazines featuring comic characters and stories. Opposer is among the most well-known and successful publishers of comic magazines in the world.

2. As early as 1960, Opposer introduced the “Justice League,” a collection of DC Comics’ both male and female fictional, heroic characters, including but not limited to Superman, Batman and Wonder Woman, who band together to fight crime and villainous characters.

3. Continuously since 1960, Opposer has produced or authorized an array of goods and services under the JUSTICE LEAGUE trademark (“Opposer’s Mark”), including but not limited to entertainment products and services such as comic books, television programs and motion pictures, as well as clothing, toys, lunchboxes, home décor, computer and video games, and accessories for mobile devices.

4. Opposer is the owner of all right, title and interest in and to Opposer’s Mark in connection with a vast array of goods and services based on first use in commerce prior to any date upon which Applicant can rely.

5. As a result of Opposer’s reputation, use, sales success, enormous popularity and significant investment in advertising, Opposer’s Mark has developed secondary meaning and significance in the minds of the public and become a strong trademark identifying Opposer’s goods and services exclusively. As such, Opposer’s Mark represents enormous goodwill and is a valuable asset to Opposer.

6. As a result of Opposer’s reputation, use, sales success, enormous popularity and significant investment in advertising, Opposer’s Mark has become a famous trademark and became famous prior to any date upon which Applicant can rely.

7. Opposer owns numerous U.S. trademark registrations for Opposer’s Mark in connection with related goods and services, including but not limited to the following:

- JUSTICE LEAGUE OF AMERICA, U.S. Reg. No. 1,190,681, for “Comic Magazines” in International Class 16;
- JUSTICE LEAGUE, U.S. Reg. No. 1,503,856, for “Comic Magazines” in International Class 16;
- JUSTICE LEAGUE, U.S. Reg. No. 2,998,011, for “Entertainment services in the nature of . . . comedy, drama and animated television series; production of . . . comedy, drama and animated . . . motion picture theatrical films” in International Class 41;

- JUSTICE LEAGUE, U.S. Reg. No. 2,998,012, for “Motion picture films featuring comedy, drama, action, adventure and/or animation, . . . audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; . . . CD ROM computer game discs; . . . mouse pads; eyeglasses, sunglasses and cases therefore . . . video and computer game programs; . . . cellular telephone covers and cellular telephone face covers; . . . and decorative magnets” in International Class 9;
- JUSTICE LEAGUE, U.S. Reg. No. 2,998,021, for various items of clothing, headwear and footwear in International Class 25;
- JUSTICE LEAGUE, U.S. Reg. No. 2,998,022, for toys and sporting goods in International Class 28;
- JUSTICE LEAGUE HEROES, U.S. Reg. No. 3,257,160, for “computer and video game programs which are designed for hardware platforms such as game consoles and personal computers; CD-ROM computer game discs and computer programs, namely, software linking digitized video and audio media to a global computer information network; video and computer game programs; video game cartridges and cassettes” in International Class 9;
- JUSTICE LEAGUE, U.S. Reg. No. 5,699,073, for “adhesive plastic bandages for skin wounds” in International Class 5;
- JUSTICE LEAGUE, U.S. Reg. No. 5,699,075, for “Glass and ceramic goods, namely, mugs, coffee cups, and cups; glass beverageware; lunch boxes; thermal insulated containers for food or beverages; water bottles sold empty” in International Class 21; and
- JUSTICE LEAGUE, U.S. Reg. No. 5,704,943, for “metal key chains, non-metal key chains; clocks; watches; jewelry” in International Class 14.

All of the registrations for Opposer’s Mark relied upon herein are valid, subsisting and in full effect and serve as prima facie evidence of the validity of the mark and of Opposer’s exclusive right to use the mark in connection with the goods and services identified therein, pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(a), and several have become incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and therefore serve as conclusive proof of Opposer’s exclusive right to use the mark in connection with the goods and services identified therein, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

8. Upon information and belief, Applicant is an individual with an address of 75 Amherst Street, Cambridge, Massachusetts 02139.

9. On December 29, 2017, Applicant filed the Application to register the mark ALGORITHMIC JUSTICE LEAGUE (“Applicant’s Mark”) for “Organizing and developing charitable projects that aim to promote awareness of and combat bias in algorithms as used in artificial intelligence and automated decision-making technology” in International Class 35 based on a first use date of October 31, 2016, pursuant to Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

10. Applicant is currently using Applicant’s Mark on her website, <https://www.ajlunited.org>, and Facebook page, <https://www.facebook.com/AJLUnited/>, as shown here:





11. Upon information and belief, prior to any date on which Applicant can rely, Applicant was on actual notice of Opposer's prior rights in and to Opposer's Mark.

12. The earliest date upon which Applicant can rely is long after the use, registration and acquisition of rights in Opposer's Mark by Opposer or its predecessors-in-interest. As such, Opposer's rights in Opposer's Mark are prior and superior to any rights Applicant may claim in Applicant's Mark. The registration of Applicant's Mark is inconsistent with Opposer's prior rights and statutory grant of exclusivity of use.

13. Applicant's Mark is similar and/or identical to Opposer's Mark in sight, sound and commercial impression.

14. Applicant's services to be offered under Applicant's Mark are sufficiently related to goods and services sold under Opposer's Mark and, upon information and belief, will be sold to the same customers or types of customers to whom goods and services bearing Opposer's Mark are sold.

15. Based on the similarity of the marks and the relatedness of the goods and services, consumers are likely to be deceived into falsely believing that the services offered by Applicant under Applicant's Mark originate from or are otherwise associated with or endorsed by Opposer,

or that there is some relationship between Applicant and Opposer or the services of Applicant and the goods and services of Opposer. Such false assumptions will cause injury and harm to Opposer because they wrest from Opposer exclusive control over the manner in which its trademark is used.

16. Thus, registration of Applicant's Mark in connection with the services set forth in the Application is likely to cause confusion, cause mistake, or to deceive the public into the false belief that the services offered by Applicant under Applicant's Mark come from or are otherwise sponsored by or connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

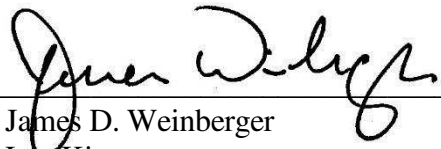
17. Moreover, Opposer's Mark is famous for goods and services relating to publications and entertainment, and had become famous long before the earliest priority date upon which Applicant can rely. Because Opposer's Mark has become famous, Applicant's use and registration of Applicant's Mark will damage Opposer by trading on the enormous goodwill associated with the Opposer's Mark and diluting its distinctiveness. Thus, Applicant's use and registration of Applicant's Mark in connection with the services identified in the Application are likely to cause dilution by blurring of the famous Opposer's Mark, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

18. By reason of the foregoing, Opposer is likely to be harmed by the registration of the Application for Applicant's Mark.

THEREFORE, it is respectfully requested that this Opposition be sustained and that registration of the Application be refused in its entirety.

Dated: New York, New York
June 20, 2019

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Leo Kittay
Sean F. Harb
151 West 42nd Street, 17th Floor
New York, New York 10036
Tel: (212) 813-5900
Email: jweinberger@fzlz.com
lkittay@fzlz.com
sharb@fzlz.com

Attorneys for Opposer